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54

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EXAMINER

GRAHAM, MARK S

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13

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 09/929,299
Filing Date: August 14, 2001
Appellant(s): GOLDSMITH ET AL.

Michael A. Tomasulo
For Appellant

EXAMINER'S ANSWER

MAILED
FEB 09 2004
GROUP 3700

This is in response to the appeal brief filed 11/21/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct. However, the rejection of claims 1 and 2 under 35 U.S.C. 102(b) has been withdrawn.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct. However, as noted above, the rejection of claims 1 and 2 under 35 U.S.C. 102(b) has been withdrawn.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1 and 2 as a group; 17-21 as a group; 22 on its own, 23-29 as a group; and 30 on its own do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

9857/1956	Malmberg	12-1959
5,607,154	Meumann et al.	3-1997
5,496,027	Christian et al.	3-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 17-21, and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malmberg in view of Meumann. This rejection is set forth in prior Office Action, Paper No. 10.

Claims 22 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malmberg in view of Christian. This rejection is set forth in prior Office Action, Paper No. 10.

Claims 1, 2, 17-21, and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meumann in view of Malmberg. This rejection is set forth in prior Office Action, Paper No. 10.

Claims 22 and 30 are rejected under 35 U.S.C. Christian in view of Malmberg. This rejection is set forth in prior Office Action, Paper No. 10.

(11) Response to Argument

Appellant's first argument relevant to the instant rejections is argument II beginning on page 10 of the brief. In response to the argument presented therein the

appellant's analysis is simply incorrect. Claims 17-21 and 23-29 require that an "outermost portion" of the upper portion of the blade be concave in the area in question. (Claims 1 and 2 do not require this "outermost portion" limitation at all). Malmberg in view of Meumann clearly shows this feature. The fact that Malmberg also discloses a reinforcement, 4, for placing over the upper portion is irrelevant to the structure which is actually being claimed. Appellant has claimed that the upper portion of the blade must have an "outermost portion" which is concave which Malmberg clearly shows. Appellant has not claimed that an "outermost portion" of a reinforcement be concave as is being argued. Appellant's highlighting of paragraph 7 on page 2 of Malmberg only strengthens examiner's point. It is the outermost portion of Malmberg's "upper portion", as appellant defines that area of the hockey stick shaft, which is concave. Appellant's further argument of claims 23-29 on page 13 of the brief fail under the same analysis. Regardless of the reinforcement, the "upper portion" of the hockey stick itself has a reduced width dimension.

In response to appellant's argument B beginning on page 13 of the brief Malmberg clearly teaches at page 1, paragraph 2, that "the shock-absorbing spring action of the club's shaft is not eliminated through the invention". Thus the limitation pertaining to the bending stiffness of the portion is met. Moreover, whatever the merits of the reinforcement, the "upper portion" of the hockey stick itself is of reduced bending stiffness which is what the claims require.

Appellant's argument C beginning on page 14 of the brief is that there would not be motivation to combine the two references and that in actuality it would be contrary to

do so as explained in lines 3-7 on page 17 of the brief. In response to this "contrary" argument the examiner notes that in the Malmberg in view of Meumann rejection it is Malmberg which is being modified. Malmberg already teaches the weakened area so it would not be contrary to weaken the hockey stick in this area. Meumann, the supporting reference merely teaches the well known replaceable blade concept for the purpose of replacing broken parts. Obviously if one applies this teaching to Malmberg, Malmberg's weakened area just above the shaft/blade transition falls in the upper portion of the blade piece of such a hockey stick as can be seen by comparing Figs. 1 of Meumann and Malmberg respectively.

Appellant's further argument in this regard as to the length of the upper portion of Meumann's blade is also clearly refuted by examining Meumann's Fig. 1. Meumann could not more definitely show that the connection point is located a considerable distance away from the blade and not "as close as possible" as appellant would wish.

Regarding the Meumann in view of Malmberg rejection, Malmberg clearly teaches the efficacy of providing a weakened portion just above the blade shaft transition as can best be seen in Malmberg's Fig. 1. One of ordinary skill in the art seeking the advantage of such a weakened portion (to get the spring action desired by Malmberg) in Meumann's stick would only logically look to the area taught by Malmberg as the proper area to weaken. In Meumann's stick this area is clearly the upper portion of the blade portion. Were appellant's claims patentable, the ordinarily skilled artisan seeking to take advantage of Malmberg's "spring action" advantage, known since 1956 would be prevented from freely doing so on Meumann's stick.

Appellant's argument D beginning on page 19 of the brief is that Malmberg does not disclose a continuous curved transition. In response, attention is directed at Fig. 3 of Malmberg and Fig. 3, 4, or 7 of appellant. If the transition of Figs. 3, 4, and 7 is a "continuous curved transition" then Malmberg's Fig. 1 also shows a "continuous curved transition" as appellant has decided to define this phrase in the context of his disclosure.

Appellant's next arguments concern the rejections based on Malmberg and Christian, and with the exception of the argument advanced at the bottom of page 25 of the brief, mirror those with regard to the Malmberg/Meumann rejections and thus the examiner's response is the same with Christian merely taking the place of Meumann.

Concerning the argument at the bottom of page 25, the precise point of Malmberg is that you can provide a more flexible area at the portion of the stick directly above the blade and retain the strength required for the stick. Thus, contrary to appellant's argument it would be completely intuitive to one of ordinary skill in the art to provide the teachings of Malmberg to Christian to obtain a springy area of the stick, while still maintaining the strength needed to prevent the stick from easily breaking. In a similar vein one of ordinary skill in the art seeking to provide a detachable blade portion for Malmberg's stick which includes a reduced thickness bendable portion would obviously have recognized the value of the teachings of Christian as to the use of fiber reinforcement to help ensure that such a detachable blade portion would be of sufficient strength which is completely desirable in Malmberg who seeks a particular bending advantage while retaining strength.

As to the location of the weakened area, while Malmberg designates it as the lower end of the shaft it is evidently clear that the location coincides with what would be the upper end of the blade on a hockey stick such as Meumann's because it is intended that the area directly above the horizontal portion of the blade is that which should be weakened.

With regard to applicant's final argument Malmberg clearly shows the continuous curved transition in Fig. 3.

Appellant's argument D beginning on page 26 of the brief is that Malmberg does not disclose a continuous curved transition. In response attention is directed at Fig. 3 of Malmberg and Fig. 3, 4, or 7 of appellant. If the transition of Figs. 3, 4, and 7 is a "continuous curved transition" then Malmberg's Fig. 1 also shows a "continuous curved transition" as appellant as decided to define this phrase in the context of his disclosure.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark S. Graham
Primary Examiner
Art Unit 3711

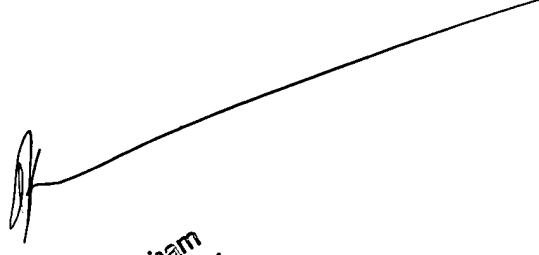
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February 5, 2004

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